



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,890	12/10/2003	James R. Lisk JR.	5N03.1-011	6906
23506 7590 04/30/2009 GARDNER GROFF GREENWALD & VILLANUEVA, PC 2018 POWERS FERRY ROAD SUITE 800 ATLANTA, GA 30339				
EXAMINER MENDOZA, MICHAEL G				
ART UNIT 3734		PAPER NUMBER		
NOTIFICATION DATE 04/30/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@gardnergroff.com
mkandeer@gardnergroff.com

Office Action Summary

Application No.

10/732,890

Applicant(s)

LISK ET AL.

Examiner

MICHAEL G. MENDOZA

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-25, 31, 32, 34-38 and 40-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-25, 31, 32, 34-38 and 40-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pgs 11-12, filed 12/23/2008, with respect to the rejection(s) of claim(s) 14, 16-20, and 25 under 35 USC 102(b) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.
2. Applicant's arguments filed 12/23/2008 have been fully considered but they are not persuasive. In response to applicant's argument that Foggia is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Foggia is reasonably pertinent to the particular problem with which the applicant was concerned. Foggia is used a teaching reference for the use of a polymer as a material for constructing an article as an alternative to metal.
3. Claims 33 and 39 are cancelled. Claims 1, 3-25, 31-32, 34-38, and 40-43 are pending.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-8, 13-20, 25, and 31, 32, 34-38, and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pallikaris et al. 7004953 in view of Foggia et al 5782852.
6. As to claims 1, 14, 31, 32, Pallikaris et al. teach a surgical device comprising: a positioning ring; and a separator assembly including a separator having a blunt separating edge; wherein the radius of curvature of the separating edge of the separator is between 5 micron and about 100 microns, or 10 microns and about 30 microns, or 15 microns and 25 microns (col. 6, lines 22-29); wherein the polymeric separating edge is flat, wherein the polymeric separating edge is rounded, wherein the polymeric separating edge includes an angled point (see fig. 23).
7. Pallikaris et al. teaches that the blade can be manufactured from a material that is strong enough to push epithelium without breaking. It should be noted that Pallikaris fails to teach the preferred materials and their properties. It is known in the art to use a polymeric blade in place of a metal blade in the surgical art as evidenced by Foggia et al. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a polymeric blade as taught by Foggia et al. as a mechanical expedient to a metal blade (see entire reference).
8. As to claims 3-8, 15-20, 25, 34 Pallikaris/Foggia teaches the claimed invention except for the properties of the polymeric material. Foggia et al. teaches the use of polymers (col. 5, lines 21-25). These polymers are also recited in the claim limitations and can be made with the same recited properties. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a polymer

having the recited structural properties, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

9. As to claim 36 and 37, Pallikaris et al. teaches a metal blade. It should be noted that Pallikaris et al. fails to teach a polymer coating on the edge of the blade. However, it is well known in the art of blades to coat the edge of a blade with a polymer, e.g., Teflon, for hardening, anticorrosive properties, or as a lubricative layer for the metal blade. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a polymer coating to the edge of the blade of Pallikaris et al. to enhance the properties of the blade.

10. As to claim 41, Pallikaris/Foggia teaches the claimed invention except for the leading edge portion size range. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed range limitations, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

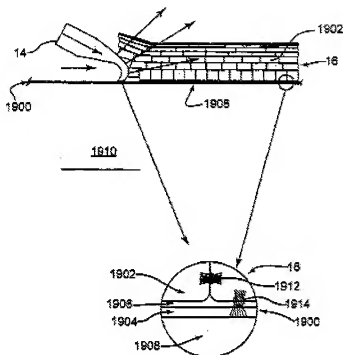


FIG. 19

11. Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pallikaris/Foggia in view of Samuels et al. 6247389.

12. Pallikaris/Foggia teaches the surgical device as claimed in claim 1.

Pallikaris/Foggia teaches the use of a non-brittle polymer blade. Samuels et al. teaches the use of fillers (glass fiber and carbon fiber) for reinforcing polymer blades. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the fillers in view of Samuels et al. to reinforce the polymer blades to make them less brittle.

13. Claim 10, 12, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pallikaris/Foggia in view of Feingold 6083236.

14. Pallikaris/Foggia teaches the surgical device as claimed in claim 1. It should be noted that Pallikaris/Foggia fails to teach wherein the polymeric edge comprises a transparent material. However, Feingold teaches the use of a transparent blade (col. 6, lines 24-25). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the polymeric blade of Pallikaris/Foggia transparent for the best visibility during the process of separation.

15. As to claims 12 and 24, the above combination teaches the device of claim 10. It should be noted that the combination fails to specifically teach the limitation of the transparent material comprises a tinting agent. However, the combination teaches that the transparent material need not transmit all light (light transmission greater than 75 percent). If the transparent material does not transmit all light, there would be some type of tint blocking the rest of the light transmission. Therefore, the above combination does teach some type of tinting agent.

16. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pallikaris/Foggia in view of Scwemberger et al. 5569292.

17. As to claims 11 and 23, Pallikaris/Foggia/Feingold teaches the device as claimed in claim 10 and 22. It should be noted the that the above combination fails to disclose a light transmission greater than about 50, and a haze factor less the 25 percent. However, Scwemberger teaches the use of a surgical blade of a plastics material with similar limitations that does not obstruct the visual field during operation (col. 7, lines 14-17). Therefore, it would have been obvious to one having ordinary skill in the art at the

time the invention was made to use the light transmission and haze factor for viewing in view of Scwemberger.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL G. MENDOZA whose telephone number is (571)272-4698. The examiner can normally be reached on Mon.-Fri. 9:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/732,890

Page 8

Art Unit: 3734

/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3734